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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/524,367 | 02/11/2005 | Fred A. Antonini | 0771MH-42176-US | 9853 |
| 38441 7590 10/04/2010 LAW OFFICES OF JAMES E. WALTON, PLLC 1169 N. BURLESON BLVD. SUITE 107-328 BURLESON, TX 76028 | | | | |
| EXAMINER LONEY, DONALD J | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1783 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 10/04/2010 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JIM@WALTONPLLC.COM

Office Action Summary

Application No.

10/524,367

Applicant(s)

ANTONINI, FRED A.

Examiner

Donald Loney

Art Unit

1783

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 10 and 13-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 10 and 13-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 18, 2010 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 10 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The above claims depend from cancelled claim 9. Correction is kindly requested.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-4 and 14-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim1, 2 and 4-6 of copending Application No. 11/072382. Although the conflicting claims are not identical, they are not patentably distinct from each other because any layer can be considered decorative to some degree since the applicant does not recite any particular structure thereto.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-4 and 14-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2 and 4-25 of copending Application No. 10/523942. Although the conflicting claims are not identical, they are not patentably distinct from each other because any layer can be considered decorative to some degree since the applicant does not recite any particular structure thereto.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 2, 15 and 17-19 are rejected under 35 U.S.C. 102(a) and/or (e) as being anticipated by Kobe et al (6372323).

Kobe et al discloses a slip control sheet comprising a decorative layer (21 or 22, which can include pigments) between an adhesive layer 34 and an anti-slip layer 21 comprising a plurality of uniformly sized rounded dimples (26, 46, 56, 78, and/or 86). Refer to figures 1-5 along with column 5, lines 1-34. With regards to claim 2, see column 5, lines 25 and 36. With regards to claims 15 and 17-19, see column 5, lines 51-62 and column 9, lines 25-63. With regards to the limitations “for application on handheld devices,” and “conforming to the shape of the handheld device” are deemed to be statements with regard to the intended use and is not further limiting in so far as

the structure of the product is concerned. In article claims, a claimed intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02. Furthermore, it is noted that Kobe's article is useful in golf clubs, baseball bats, household articles, non-slip walking surfaces etc. (*col. 1, lines 60-64*). The intended uses of Kobe's article include Applicant's intended uses for their film.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 3, 4, 14, 16 and 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobe et al in view of WO 00/08622 to Neal.

The primary reference teaches the invention substantially as recited except for the printed decorative layer per claims 4 and 14, along with the product comprising two portions of the same product per claim 20. See the 35 U.S.C. 102 rejection above.

Neal discloses that an anti-slip label can be formed with the anti-slip-layer 4 and decorative printed layer/label (6). See figures 1-3, page 8, lines 7-9 and page 10, lines 6-10.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Kobe et al to form the decorative layer of a printed label stock, as is taught to be known by Neal, since this would merely involve the pigmented decorative layer comprising printing which would supply the decorative feature thereto. With regards to claims 3, all layers above print layer 6 can be transparent in order to be able to view the print layer in Neal (see page 9, lines 18-20). With regards to claims 20 and 21, this would merely involve a duplication of parts which is generally considered within ordinary skill in the art. See PMEP 2144.04VI. With regards to claim 14, the product is label stock (see Abstract and page 8, lines 26-28). With regards to claims 23-25, see column 5, lines 51-62 and column 9, lines 25-63 in Kobe et al.

12. Claims 1-4 and 14-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO/ 00/08622 to Neal in view of WO 01/87581 to Perez Carballo (of which EP 129334 is an English language equivalent thereof), or visa versa.

Neal discloses a sheet comprising a printed decorative layer 6 located between an adhesive layer 2 and a top anti-slip layer 4/5. Refer to figures 1-3. The product is

disclosed as having anti-slip properties (page 10, lines 6-10). Neal does fail to disclose the top layer include a plurality of uniformly sized rounded dimples.

WO '581 discloses it is known to from a plurality of uniformly sized dimples 2' on the top surface of a nonslip in order to supply the nonslip properties thereto.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Neal to include dimples on the top layer, as taught by WO '581, in order to increase, or add to the anti-slip properties of this layer since dimples are known to provide such properties.

Alternatively, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a printed decoration layer and adhesive layer, as taught by WO '581, onto the back side of Neal in order to form a laminated structure as recited motivated by the fact WO '581 discloses the product can be a laminated label (see paragraph [0007] in EP '334).

With regards to claims 3, all layers above print layer 6 can be transparent in order to be able to view the print layer in Neal (see page 9, lines 18-20). With regards to claim 4, a print layer 6, or printing on layer(s) 3 are disclosed (see layer 6 and page 9, lines 1-14) in Neal. With regards to claims 20 and 21, this would merely involve a duplication of parts which is generally considered within ordinary skill in the art. See PMEP 2144.04VI. With regards to claim 14, the product is label stock (see Abstract and page 8, lines 26-28). With regards to claims 15, 17-19 and 23-25, see column 5, lines 51-62 and column 9, lines 25-63 in Kobe et al. With regards to the limitations "for application on handheld devices," and "conforming to the shape of the handheld device" are deemed to be

statements with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

Response to Arguments

13. Applicant's arguments with respect to claims 1-4, 12 and 13-25 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Donald J. Loney/
Primary Examiner
Art Unit 1783

DJL;D.Loney
09/28/10